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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,598	06/27/2003	Ben Huang	WINN.001A	2270
20995 7590 05/31/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER BLAU, STEPHEN LUTHER	
			ART UNIT 3711	PAPER NUMBER
			NOTIFICATION DATE 05/31/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/608,598

Applicant(s)

HUANG, BEN

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 25-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 32-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/6/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed 6 April 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- a. The urethane monomers in claim 34.
- b. The accelerator of urethane coagulation in claim 35.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 34-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 34 recites the limitation "urethane monomers" in lines 4-5. Claim 35 recites the limitation "accelerator of urethane coagulation" in line 2. There is insufficient antecedent basis for these limitations in the specification.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4, 6-11, 13-16, 19, 22 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeh in view of Yasui and Shirono.

Yeh discloses a grip formed of an elongated strip comprising an elastomer (Col. 2, Lns. 52) layer (12) bonded (Claim 1) to a felt layer (Col. 2, Lns. 54-56), an elastomer being a thermoplastic urethane, thermoplastic rubber (Col. 2, Lns. 51-56), and a polyurethane (Col. 2, Lns. 51).

Yeh lacks a powdered inorganic antimicrobial agent dispersed in an elastomer, an antimicrobial agent of silver in a porous based carrier of a silica-alumina carrier and the concentration by weight of an inorganic antimicrobial agent being about 2%. Yasui discloses an antibacterial material in an elastomer grip formed from synthetic resin (Col. 2, Lns. 61-64), synthetic resins including by not limited to rubber based elastomers, urethane rubber, and thermoplastic elastomers (Col. 2, Lns. 65 through Col. 3, Ln. 7), a grip (Col. 1, Lns. 21-27) for sporting equipment in the form of a fishing pole (fig. 1), antibacterial and antifungal material (Col. 2, Lns. 61-64) in the form of pellets (Col. 1,

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Lns. 65-67) of inorganic material of silver in a porous (Col. 1, Lns. 53-56) silica-alumina or zeolite carrier (Col. 3, Lns. 8-20), BACTEKIRANI, NOVALON (Table 1), resin being formed by melting synthetic resin with antibacterial pellets (Col. 1, Lns. 65-67) and the concentration by weight of an inorganic antimicrobial agent is from .2 to 3 % (Tables 1-2) in order to cause less skin irritation and offer improved durability (Col. 3, Lns. 8-20). Yasui does not specifically state that the antibacterial agent is dispersed in the synthetic resin but clearly one skilled in the art of forming a molded composite grip with pellets of antibacterial agents in would have located the pellets in a suitable location in which dispersed therein is included. Shirono discloses an inorganic antimicrobial agent being a powdered in the form of a metal being carried on zeolite (Col. 1, Lns. 5-14) as Yasui teaches. Clearly the art interchanges the terms of a pellet and a powder for an inorganic antimicrobial agent when a metal is carried on a carrier. In view of the patent of Yasui it would have been obvious to modify the sporting golf grip of Yeh to have a synthetic resin grip made of thermoplastic rubber, urethane layer or a polyurethane layer comprising silver metal in a porous silica-alumina or zeolite carrier having a concentration by weight of an inorganic antimicrobial agent being about 2% in order have a golf grip with anti bacterial and antifungal properties and in order to cause less skin irritation and offer improved durability for golf grip having an elastomer having an antibacterial agent while playing a round of golf. In view of the patent of Yasui it would have been obvious to modify the sporting golf grip of Yeh to have the antimicrobial agent dispersed therein the elastomer in order to ensure the agent is throughout the elastomer providing antimicrobial protection instead of at only one portion of the grip

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material. In view of the patents of Yasui and Shirono it would have been obvious to modify the grip of Yeh to have the inorganic antimicrobial agent comprising a powder in order to utilize a form of an inorganic antimicrobial agent used in the market place.

6. Claims 12, 17-18, 20-21 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeh in view of Yasui and Shirono as applied to claims 1-2, 4, 6-11, 13-16, 19 and 22 above, and further in view of Hayashi.

Yeh lacks an inorganic antimicrobial silica-alumina being montmorillonite having the formula as defined by claim 12. Yasui discloses inorganic material of silver in a porous (Col. 1, Lns. 53-56) silica-alumina or zeolite carrier (Col. 3, Lns. 8-20). Shirono discloses an inorganic antimicrobial agent being a powdered in the form of a metal being carried on zeolite (Col. 1, Lns. 9-11). Hayashi discloses a suitable substitute for an inorganic antimicrobial of silver in a zeolite carrier being silver in a montmorillonite carrier (Col. 3, Lns. 42-49). In view of the patent of Hayashi it would have been obvious to modify the grip of Yeh to have an inorganic antimicrobial agent being silver in a montmorillonite carrier in order to utilize an inorganic antimicrobial agent available in the market place if metal being carried on zeolite was not available. As such the carrier would have the formula as defined by claim 12 [0027].

7. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeh in view of Yasui and Shirono as applied to claims 1-2, 4, 6-11, 13-16, 19 and 22 above, and further in view of Huang (5,695,418).

Yeh discloses a textile layer have an adhesive layer in the form of a double sided adhesive tape (Col. 1, Lns. 33-39) and a polyurethane (Col. 2, Lns. 51).

Yeh lacks a polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip and a protective quick-release tape. Huang discloses a grip being an elongated strip (Fig. 5), a grip tape with polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip in order to have enhanced compression (Col. 4, Lns. 8-20), an adhesive layer, and a protective quick-release tape (Fig. 4). In view of the patent of Huang it would have been obvious to modify the grip of Yeh to have a grip tape with polyurethane having closed pores that extend vertically in a direction normal to a longitudinal axis of a strip in order to have enhanced compression when gripping a polyurethane grip. In view of the patent of Huang it would have been obvious to modify the grip of Yeh to have a protective quick-release tape in order to prevent the strip adhesive from sticking on things until it is ready to be placed on a handle.

8. Claims 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobson (5,180,585) in view of Huang (5,695,418).

Jacobson discloses a powdered inorganic antimicrobial agent (Col. 1, Lns. 5-12) dispersed as a filler in a elastomer in the form of a rubber (Col. 8, Lns. 49-58), polyurethane (Col. 9, Lns. 19-20), polymer articles as films (Col. 9, Lns. 30-35), coatings (Col. 8, Lns. 47, Col. 11, Lns. 36-45) and dispersing the antimicrobial particulate in a polymer solution prior to coagulation of the polymer (Col. 12, Lns. 39-49) by an

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accelerator in the form of a non-solvent (Col. 12, Lns. 46-47) in order to control microorganisms (Abstract).

Jacobson lacks a grip having an elastomer layer having a plurality of closed pores bonded to a textile layer, and a process of coating one side of a textile layer with a solution comprising urethane monomers and the powdered inorganic antimicrobial agent and coagulating the urethane monomers such that the powdered inorganic antimicrobial agent is dispersed within the polyurethane.

Huang discloses a grip having an elastomer layer in the form of polyurethane for cushioning (Col. 2, Lns. 13-17) having a plurality of closed pores (22) bonded to a textile layer (Col. 2, Lns. 51-67) formed by coagulation (Col. 2, Lns. 58-64), and a process of coating one side of a textile layer with a solution comprising urethane monomers coagulating the urethane monomers with an accelerator of urethane coagulation in the form of a non-solvent of water (Col. 2, Lns. 58-67). In view of the patent of Huang it would have been obvious to modify the polyurethane film coating of Jacobson to have an elastomer layer having a plurality of closed pores bonded to a textile layer and a process of coating one side of a textile layer with a solution comprising urethane monomers and the powdered inorganic antimicrobial agent and coagulating the urethane monomers such that the powdered inorganic antimicrobial agent is dispersed within the polyurethane in order to provide an antimicrobial agent to the grip of Huang in order to control microorganisms on a grip of a golf club.

Response to Arguments

9. The argument that Yasui is improper in that it is not a powder since only 10 % of the pellet is the inorganic antimicrobial agent is disagreed with. The applicant's and Yasui's inorganic antimicrobial agents are silver with the same porous carrier. They both have the same structure. If Yasui is not a powder then the applicant's agent is not a powder. The argument that it is improper to use the reference of Shirono due to Shirono not disclosing a powder agent but a colloidal solution of inorganic oxide is disagreed with. The examiner was not using the invention of Shirono but what Shirono disclosed as prior art to show that it is known to have an antibacterial agent in powder form (Col. 1, Lns. 11-15). The argument that it is improper to use Shirono due to Shirono pointing out numerous problems associated with powdery antibacterial compositions and provides a solution to powdery compositions is disagreed with. Even though Shirono points to the disadvantages of the powdery antibacterial compositions it does not negate the fact that they exist and others have thought them to be advantageous to use though Shirono at the time of filing may not. The argument that it is improper to combine Yeh, Yasui and Shirono since none of them recite a polyurethane and felt to reduce impact related shock is disagreed with. Yeh clearly discloses that the polyurethane is an elastomer which will reduce impact related shock with or without being attached to the felt layer.

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Barry, EP 0 677 989 and Hagiwara disclose inorganic antimicrobial agents in a polymeric material. Bries, Ishida and Erdem disclose adding antimicrobial additives in coagulated polyurethanes.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/24 May 2007



STEPHEN BLAU
PRIMARY EXAMINER